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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,365	01/31/2001	Suman Khowala	8920-000005	3998

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EXAMINER
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SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/773,365</b>	Applicant(s) <b>Khowala et al.</b>
Examiner <b>Sandra Saucier</b>	Art Unit <b>1651</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_
- 2a)  This action is **FINAL**.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-12 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- a)  All b)  Some\* c)  None of:

- 1)  Certified copies of the priority documents have been received.
- 2)  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3)  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_      20)  Other

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#### DETAILED ACTION

Claims 1-12 are pending and are considered on the merits.

##### *Claim Rejections – 35 USC § 112*

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

At least some of the claims require one of ordinary skill in the art to have access to a specific microorganism. Because the microorganism is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the microorganism is not so obtainable or available, the requirements of 35 USC 112 may be satisfied by deposit of the microorganism. The specification does not disclose a repeatable process to obtain the microorganism and it is not clear from the specification or record that the microorganism is readily available to the public.

The objection and accompanying rejection may be overcome by establishing that each microorganism identified is readily available to the public and will continue to be so for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer, or by an acceptable deposit as set forth herein. See 37 CFR 1.801–1.809. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or a statement by an attorney of record over his/her signature and registration number, stating that the deposit has been made under the Budapest Treaty and that all restrictions imposed by the depositor on availability to the public of the deposited material will be irrevocably removed upon issuance of the patent would satisfy the deposit requirement. See 37 CFR 1.808.

If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria, assurance must be provided to the effect that:

- (1) during the pendency of the application, access to the cultures will be made available to one determined by the Commissioner to be entitled thereto;
- (2) any restrictions on availability of the deposits to the public will be irrevocably removed upon the granting of a patent;
- (3) the deposits will be maintained for a term of at least of 30 years from the date of deposit and at least 5 years after the last request for the material;

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(4) a viability statement in accordance with the provisions of 37 CFR 1.807; and  
(5) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

Assurance may be provided in the form of an affidavit, declaration or averment under oath or by a statement of the attorney of record over her or his signature and registration number.

The specification must also state the date of deposit, the number granted by the depository and the name and address of the depository. See 37 CFR 1.803-1.809 for additional explanation of these requirements.

#### INDEFINITE

Claim rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, "characters" should be "characteristics", "bio chemical" should be "biochemical". In I), "a" should be inserted before "silky". In v), the period should be deleted and "Hyphae" should not be capitalized. In xiii), the period should be deleted and the names of the enzymes should not be capitalized.

Claim 3, the material in parenthesis should be deleted "(the edible mushroom)". Only the ATCC number is needed. The other accession number and the parenthesis should be deleted. Step (c) should delete "and also for" and "for use".

Claim 4 has many periods and should be corrected as in claim 2.

Claim 5 does not further limit claim 3 because the range is larger. Note the different concentration terms.

Claim 6 should delete "the strain is cultivated on", change "containing" to "contains" or "comprises", delete ", in presence of glycosylation inhibitors". The glycosylation inhibitor is already required in claim 3.

Please clarify claim 7, it is difficult if not impossible to determine what might

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be in the culture medium. Also, there is no "assimilable carbon source" in claim 3. Perhaps claim 6 is meant.

There are no class of "glycosylation inhibitors" in claim 3. Please correct claim 8 as it has no precedent.

In claim 9, there are no "assimilable nitrogen sources" in claim 3.

Claim 10 is dependent on a non-existent claim (13).

Claim 11 also has no precedent in claim 3.

Claim 12 should italicize the fungi name. Claim 12 does not further limit claim 3.

Dependent claims should begin with "The", not "A".

*Claim Rejections - 35 USC § 102 or 35 USC § 103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and

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invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by or under 35 U.S.C. 103 as being obvious over Bhattacharyya *et al.* [U] or Roy *et al.* [V] or Sengupta *et al.* [W] or Sengupta *et al.* [X].

The claims are directed to a strain of *Termitomyces clypeatus*.

The references all disclose a strain of *Termitomyces clypeatus*. All of the cited references disclose that their strain of *T. clypeatus* produces cellobiase and other glucohydrolytic enzymes.

The Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not applicants' strain differs and, if so, to what extent from the strains discussed in the references. Accordingly, it has been established that the prior art strains, which have the same genus and species classification and share the property of being able to produce cellobiase and other enzymes to hydrolyze cellulose demonstrate a reasonable probability that it is either identical or sufficiently similar that whatever differences exist are not patentably significant. Therefore, the burden of establishing novelty or unobviousness by objective evidence is shifted to applicants.

Merely because a characteristic of a known strain is not disclosed in a reference does not make the known strain patentable. The known strain possess inherent characteristics which might not be displayed in the tests used the reference. However, the microbe disclosed may be the same microbe as claimed. Clear evidence that the strains of the cited prior art do not possess a critical characteristic that is possessed by the claimed strain, would advance prosecution and might permit allowance of claims to applicants' strain.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30AM to 6:00PM Tuesday-Friday and every other Monday.

Any inquiry concerning this communication or earlier communications from

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the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of papers is (703) 308-2742 or (703) 305-3592.



Sandra Saucier  
Primary Examiner  
Art Unit 1651  
December 12, 2001